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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,411	07/16/2003	James Peter DeWelt		4855

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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/619,411	Applicant(s) DEWELT, JAMES PETER	
	Examiner Kent L. Bell	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 7/16/03*
- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/16/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input checked="" type="checkbox"/> Other: <u>U.S. PLANT PATENT 12,712</u> |

K.L. Bell

Detailed Action

Objection to the Drawing

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustration filed July 16, 2003 is objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustration should not be mounted (37 CFR 1.84(e)). Further, only a photographic illustration along with a figure legend number should be on the sheet, i.e. Figure 1 or Fig. 1. The description and other language set forth on the illustration should be set forth in the specification under a heading entitled "Brief Description of the Drawings" or something similar.

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

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(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, line 1 should be deleted as this recitation is unnecessary.

B. Page 1, line 2, Applicant should delete this line and replace it with the following recitation centered:

- -Papaver Plant Named 'Heartbeat' - -.

C. Page 1, after line 2, before line 3, The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37

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CFR 1.163(d). This information should be set forth after line 2 before line 3 as set forth in 37 CFR 1.163(c).

D. Page 1, lines 7-9, Rather than stating “PAPAVER” in all caps, applicant should set forth “PAPAVER” as “Papaver”. Further, all the Genus and species set forth should either be italicized or underlined as this is the proper way to set forth a Genus and species.

E. Page 1, lines 10 and 11, Applicant states “propagated by root cuttings and coming 100% true after 3 generations at trials”. Applicant states “coming 100% true”. It is not understood what this recitation means, i.e. coming true to what, the original plant or something else. It appears applicant means the original plant. If accurate, it is suggested that Applicant insert the following recitation in the specification - -The instant plant reproduces true to type in successive generations of asexual reproduction.- - after “trials”.

Further, applicant has stated how the instant plant was asexually reproduced however, applicant has not stated where the instant plant was asexually reproduced. Applicant should set forth in the specification where the instant plant was asexually reproduced.

F. Applicant states one parent is a plant which was derived through various crosses using various Papaver species. Applicant then states the other parent is a *Papaver orientale* cultivar.

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Applicant has not stated whether the parental cultivars are named or unnamed. Applicant should set forth in the specification the names of the parental cultivars, if named. If unnamed, applicant should simply state the parental cultivars are unnamed.

G. Page 2, line 3, Applicant states “The plant listed above”. It is unclear which plant applicant is intending. Clarification is necessary.

H. Page 2, lines 6-10, and Abstract, Applicant should either italicize or underline the Genus and species set forth as this is the proper way to set forth a Genus and species.

I. Applicant should set forth in the specification a brief comparison between the instant plant and its parental cultivars. Such need not be in any great detail but should at least distinguish the plants from each other. The comparison on Page 1, lines 16-22, appears to be a comparison with one of the parental species not the parental plants.

J. Page 2, lines 11-13, Applicant should delete “Mohn’s Nursery Attascadero” and “Water Meadow Nursery.” as these recitations constitute unwarranted advertising (MPEP 1610).

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K. Page 2, line 17, Applicant should set forth in the specification the typical and observed plant diameter.

L. Page 2, line 18, Applicant states “Mound forming to 20 inches”. This recitation is unclear as it is not understood whether applicant intends the leaves to be 20 inches in length or that the height from the soil to the top of the foliage plane is 20 inches. Correction and/or clarification is necessary.

M. Page 2, lines 18-22, Applicant should set forth in the specification additional information relative to the instant plant’s leaves including the typical and observed leaf shape, length, width, and apex, margin, and base descriptors.

N. Page 2, lines 20-22, Applicant sets forth a coloration for the instant plant’s leaf. However, it is unclear whether the coloration set forth is for the upper, lower, or both surfaces. Applicant should set forth in the specification a coloration for the upper and lower leaf surfaces with reference to the employed color chart.

O. Applicant should set forth in the specification whether the leaves are petiolate or sessile. If the leaves are petiolate, applicant should set forth in the specification the typical and

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observed petiole length, diameter, and coloration with reference to the employed color chart. If the leaves are sessile, applicant should simply state in the specification the leaves are sessile.

P. Page 3, lines 1-4, Applicant should set forth in the specification additional information relative to the instant plant's flowering stem including the typical and observed flowering stem length, diameter, and coloration with reference to the employed color chart.

Q. Page 3, lines 5 and 17, "Fig # 1a" and "fig# 1a" should be deleted and - -Fig. 2- - should be inserted in its place as figure numbers should be listed consecutively.

R. Page 3, lines 5 and 6, Applicant should set forth in the specification additional information relative to the instant plant's bud including the typical and observed bud coloration with reference to the employed color chart.

S. Page 3, line 6, Applicant states "Size Ht: 2.25 x 1.25 inch". This recitation is not understood as it is unclear what applicant is intending. It is not understood whether applicant is setting forth two heights since applicant states "Size Ht" or if applicant meant a length and a diameter such as "Size: 2.25 x 1.25 inches". Correction and/or clarification is necessary.

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T. Page 3, line 8, Applicant should set forth in the specification additional information relative to the instant plant's flower including the typical and observed flower depth, how the flower is borne, i.e. solitary, and whether or not a fragrance is produced.

U. Page 3, lines 10-13, Applicant should set forth in the specification additional information relative to the instant plant's petal including the typical and observed petal shape, length, diameter, and apex and base descriptors.

V. Page 3, lines 14-16, Applicant sets forth in the specification coloration for the instant plant's flowers. Applicant should set forth in the specification the typical and observed coloration for the instant plant's petals (both surfaces) with reference to the employed color chart.

W. Page 3, lines 19 and 22, Applicant states vein lines and blotches are "Black" or "black" in colour. Applicant should set forth in the specification a color designation for the "Black" and "black" coloration. The recitations "Black" and "black" are vague and insufficient in this regard.

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X. Applicant should set forth in the specification information relative to the instant plant's bracts including the typical and observed bract number, shape, length, diameter, apex, base, and margin descriptors, and coloration (both surfaces) with reference to the employed color chart.

Y. Page 4, lines 1-6, Applicant should set forth in the specification additional information relative to the instant plant's seed capsule including the typical and observed seed capsule length.

Z. Page 4, line 6, Applicant states the instant plant's seed capsule is "green blue". Applicant should set forth in the specification a color designation for the "green blue" coloration. The recitation "green blue" is vague and insufficient in this regard.

AA. Applicant should set forth in the specification information relative to the instant plant's seed including the typical and observed amount per capsule, size, and coloration with reference to the employed color chart.

AB. Applicant should provide information relative to the instant plant's reproductive organs including pistil number, anthers, stigma, styles, ovary/ies, (such as quantity, size and coloration of organs) into the specification with reference to the color chart employed (if

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available). If pollen is produced, such should be accounted for in general terms relative to the quantity and in coloration by way of reference to the color chart employed.

AC. Applicant should set forth in the specification information relative to the instant plant's Disease/Pest Resistance/Susceptibility.

AD. Applicant should set forth in the specification information relative to the instant plant's winter hardiness, i.e. USDA hardiness zone or similar.

AE. Page 5, lines 2-4, Applicant should delete "1a" and "2" and insert - -2- - and - -3- -, respectively, as drawings should be listed consecutively. Further, the information set forth on the drawing sheets should be more appropriate set forth at this location in the specification.

AF. Pages 6, 7, and 8, should be deleted as it appears these are the sheets used to mount the photographic illustrations onto. Further, the information set forth on these sheets should be set forth in a more appropriate section of the specification, for instance page 5, as stated above in "AE".

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AG. Applicant should set forth in the specification the time it takes to produce a finished flowering plant.

AH. Applicant should set forth in the specification information relative to the instant plant's sepals including the typical and observed sepal number, shape, length, diameter, apex, base, and margin descriptors, and coloration (both surfaces) with reference to the employed color chart.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Detailed Action

Comments

Applicant should review the attached U.S. Plant Patent (U.S. Plant Patent 12,712) and use it as a guide for writing future U.S. Plant Patent applications. This is a typical U.S. Plant Patent for this market class and shows the botanical characteristics typically set forth for this type of plant. This U.S. Plant Patent further shows the arrangement of a typical specification.

Applicant should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Applicant should send all correspondence to the following address:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (571) 272-1600.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL
PRIMARY EXAMINER

Kent L. Bell